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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHEVALIER, ROBERT

ART UNIT PAPER NUMBER

2615

DATE MAILED: 01/26/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/453,023

Applicant(s)

HEREDIA ET AL.

Examiner

Bob Chevalier

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-37, drawn to a method of playing back a recorded signal in combination with the feature of "reproducing the recorded signal using previously stored preferences if the recording identifier is.....if the recording identifier is not found in the playback preference database", classified in class 386, subclass 105.
 - II. Claims 38-45, drawn to at least one database stored on a computer readable medium in combination with the feature of "a disc identifier when the recorded signal is obtained from a digitally encoded, a filename when the recorded signal is obtained from a digitally encoded file on a mass storage device", classified in class 386, subclass 125.
 - III. Claims 46-51, drawn to a method of controlling audio/video devices in combination with the feature of "the multiplexer circuit to route the first source to the first output", classified in class 386, subclass 98.
 - IV. Claims 52-54, drawn to a method of providing a graphical user interface for an audio/video control device in combination with the feature of "displaying on a video display device a first graphical user interface for the selected source", classified in class 386, subclass 52.

The inventions are distinct, each from the other because of the following reasons:

The four groups of inventions are useable apart from each other and have unique specific structures not required of the other, and can therefore be separately useable as distinct inventions. For example, the method of playing back a recorded signal in combination with the feature of "reproducing the recorded signal using previously stored preferences if the recording identifier is.....if the recording identifier is not found in the playback preference database" as specified in claim 1 of Group I does not require the feature of "a disc identifier when the recorded signal is obtained from a digitally encoded, a filename when the recorded signal is obtained from a digitally encoded file on a mass storage device" as recited in claim 38, of Group II; the feature of "the multiplexer circuit to route the first source to the first output" as recited in claim 46, of Group III; and the feature of "displaying on a video display device a first graphical user interface for the selected source" as recited in claim 52 of Group IV.

Moreover, the at least one database stored on a computer readable medium in combination with the feature of "a disc identifier when the recorded signal is obtained from a digitally encoded, a filename when the recorded signal is obtained from a digitally encoded file on a mass storage device" as specified in claim 38 of Group II does not require the feature of "reproducing the recorded signal using previously stored preferences if the recording identifier is.....if the recording identifier is not found in the playback preference database" as specified in claim 1 of Group I; the feature of "the multiplexer circuit to route the first source to the first output" as recited in claim 46, of Group III; and the feature of "displaying on a video display device a first graphical user interface for the selected source" as recited in claim 52 of Group IV.

Moreover, the method of controlling audio/video devices in combination with the feature of “the multiplexer circuit to route the first source to the first output” as specified in claim 46 of Group III, does not require the feature of “reproducing the recorded signal using previously stored preferences if the recording identifier is.....if the recording identifier is not found in the playback preference database” as specified in claim 1 of Group I; the feature of “a disc identifier when the recorded signal is obtained from a digitally encoded, a filename when the recorded signal is obtained from a digitally encoded file on a mass storage device” as recited in claim 38, of Group II; and the feature of “displaying on a video display device a first graphical user interface for the selected source” as recited in claim 52 of Group IV.

Furthermore, the method of providing a graphical user interface for an audio/video control device in combination with the feature of “displaying on a video display device a first graphical user interface for the selected source” as specified in claim 52 of Group IV, does not require the feature of “reproducing the recorded signal using previously stored preferences if the recording identifier is.....if the recording identifier is not found in the playback preference database” as specified in claim 1 of Group I; the feature of “a disc identifier when the recorded signal is obtained from a digitally encoded, a filename when the recorded signal is obtained from a digitally encoded file on a mass storage device” as recited in claim 38, of Group II; and the feature of “reproducing the recorded signal using previously stored preferences if the recording identifier is.....if the recording identifier is not found in the playback preference database” as specified in claim 1 of Group I.

2. Because these inventions are distinct for the reasons given above and the search required for one Group is not required for the other, and have acquired a separate status in the art and because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 703-305-4780. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on 703-308-9644. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.


ROBERT CHEVALIER
PRIMARY EXAMINER

B. Chevalier
September 24, 2003.